

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Patent Application of

Thomas BREITBACH et al.

Examiner: Lu, Zhyu

Serial No.: 09/936,834

Art Unit: 2618

Date Filed: September 17, 2001

Docket No.: P-44 MG

Confirmation No.: 1508

Title: Method for Using Standardized Bank Services via the Internet

Commissioner of Patents, U.S. Patent Office
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR COMPLETE OFFICE ACTION AND
REQUEST FOR WITHDRAWAL OF FINALITY**

Sir:

Applicants acknowledge the Office Action dated September 25, 2006. However, the Office Action fails to respond to all of the arguments made in the Amendment filed on June 23, 2006 and is made final despite new grounds of rejection being introduced for claims 1 and 21. Applicants request that: 1) the Office Action be corrected or supplemented to include a response to the noted arguments; and 2) that the finality of the office action be withdrawn.

Request for Complete Office Action

In the Amendment filed on June 23, 2006, applicants amended independent claim 1 to include the limitations in dependent claim 2 of splitting the customer end HBCI system into two components, the SIM card of the mobile station and an HBCI gateway, and argued that it would not be obvious to modify Hultgren to include these limitations of original claim 2 (see page 9,

lines 16-19, and page 10, lines 17-20). Although the outstanding Office Action does contain a Response to Arguments section in which it responds to other arguments, it does not mention, much less respond, to these arguments based on the limitations of original claim 2.

Applicants also made arguments that the limitations of claim 21 were not suggested by the Hultgren patent (see page 10, last paragraph). The Response to Arguments relies upon an additional reference, but the rejection of claim 21 on pages 6-7 is not changed accordingly, and it is unclear how the arguments on claim 21 are addressed.

According to MPEP 707.07(f), the Office Action should contain a response to these arguments. Applicants thus request that the Office Action be corrected or supplemented to include a response to applicants' arguments that the limitations of claims 2 and 21 are not suggested by the Hultgren patent. Pursuant to MPEP 710.06, applicants request a time period of at least one month in which to respond to any such corrected or supplemental Office Action.

Request for Withdrawal of Finality

Applicants respectfully submit that the outstanding Office Action should not be made final because it changes the grounds of rejection for claims 1-21. The first grounds of rejection for claims 1 and 21 in the first Office Action dated March 23, 2006 rejected those claims based solely on U.S. Patent No. 6,868,391 to Hultgren. However, the second grounds of rejection in the second Office Action makes additional assertions that are not based on the Hultgren patent.

With respect to claim 1, it is now asserted for the first time in the second grounds of rejection that HBCI "provides support for multibanking, platform independent, and DES- and RSA- encryption and signatures for chip card" (see page 4, last two lines). It is also asserted that HBCI "provides more security and banking functions" and is "providing more banking functions

and support" than the Telepay system described in the Hultgren patent. The Hultgren is not relied upon for these assertions and it is not known what additional reference is being relied upon to support these assertions. It is noted that the Office Action makes clear when it relies upon the HBCI Interface specification document, such as in the rejection of claims 24-28, 30-31 and 34.

With respect to claim 21, an additional reference "At the Coal-face Between Financial Industries and Politics: An Interview with the Financial Issues Working Group's Chairman Charles Goldfinger" is explicitly cited (see page 2, last six lines) in the Response to Arguments as mentioned above. It appears that a new grounds of rejection is intended for claim 21.

The use of Form Paragraph 7.39 making the Office Action final is only appropriate when the grounds of rejection does not change. Since the grounds of rejection have changed for claims 1 and 21, and applicants will have to respond to the new assertions in the new grounds of rejection in order to traverse the rejections of claims 1 and 21, it is not appropriate to make the Office Action final. See MPEP 706.07.

Dated: December 26, 2006

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Respectfully submitted,

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